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CERTIFICATE OF MAILING

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ELI LILLY AND COMPANY

By S R Reades Date 3-20-01

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Suad Efendic	
Serial No.	: 09/400,802	Group Art Unit: 1653
Filed	: September 22, 1999	
For	: Use of GLP-1 or analogs in Treatment of Stroke	Examiner F. Moezie
Docket No.	: X-11158	

Response to Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231
Sir:

Enclosed herewith is a petition for an extension of time under 37 C.F.R. § 1.136. The petition authorizes the office to charge the necessary fee under 37 C.F.R. § 1.17(a) to Deposit Account No. 05-0840 in the name of Eli Lilly & Co.

Claims 1-13 of this Application are currently pending. The Examiner has made a restriction requirement under 35 U.S.C. § 121. Applicants provisionally elect with traverse Group II and the species Val^8-GLP-1(7-37) [SEQ ID NO: 5]. Applicant is unclear how to elect an "ultimate specie." Neither the M.P.E.P. nor the Code of Federal Regulations addresses this requirement asserted by the Examiner. Further, there are numerous changes that can be made to native GLP-1 to generate analogs with activity. Applicants have described hundreds of these compounds in the Specification and all of these compounds have the common structural feature of the GLP-1 backbone. Applicants respectfully request that the

requirement for restriction be reconsidered primarily because the Examiner has improperly restricted out members of a Markush group.

The Examiner has indicated that because GLP-1 compounds, GLP-1 analogs, GLP-1 derivatives, compounds that act through the GLP-1 receptor, and compounds that enhance insulin sensitivity by acting through the GLP-1 receptor may be classified in different subclasses depending on the structure of the molecule, that the use of each of these compounds to treat stroke is a distinct invention.

Claim 1 encompasses the use of GLP-1, GLP-1 analogs, GLP-1 derivatives, and salts thereof to reduce the mortality and morbidity associated with stroke. These compounds are described extensively throughout the specification and share the common structural feature of the GLP-1 backbone. GLP-1 compounds which include analogs, derivatives, variants, precursors and homologues are discussed beginning on page 5, line 25. The sequence of native GLP-1(7-37) is provided at the bottom of page 5 and top of page 6. GLP-1 analogs are defined and exemplified on page 6, lines 3-12. Additional analogs which generally have one or two substitutions at various positions of native GLP-1(7-37) are described on page 6, line 26 through page 15. GLP-1 analogs that are resistant to DPP-IV cleavage are preferred and these analogs are discussed on page 12, lines 1-6. GLP-1 derivatives are defined and exemplified on page 6, lines 12-25. Additional derivatives are described on page 9 and pages 12 through 15.

These GLP-1 compounds are claimed as a Markush group. Applicant respectfully asserts that it is not proper to restrict out members of a Markush group especially when the compounds included within the group share a common utility and a substantial structural feature. *See* M.P.E.P. § 803.02. The compounds restricted out by the Examiner in this case share a common utility in that they have insulinotropic activity. They share common structural features of the native GLP-1 backbone, and they are all able to bind and activate a signal

through the GLP-1 receptor.

In distinguishing restriction requirements made between different claims and those made in the context of a Markush group, the Federal Circuit noted that "it is *never* proper for an examiner to reject a Markush claim under 35 U.S.C § 121. Section 121 simply does not authorize such a rejection." *In re Watkinson*, 900 F.2d 230, 232 (Fed. Cir. 1990). The M.P.E.P. § 803.02 points out two specific cases where the Board of Appeals reversed an Examiner's decision to restrict out claims of a Markush group. *See In re Weber,* 580 F.2d 455 (C.C.P.A. 1978); *In re Haas*, 580 F.2d 461 (C.C.P.A. 1978). In *Weber*, the court stated that "an applicant has a right to have Each claim examined on the merits" and noted that if a single claim is required to be divided up, that claim would never be considered on its merits. 580 F.2d at 458. The court held that while section 121 allows the restriction of independent and distinct inventions, "[i]t does not . . . provide a basis for an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis." *Id.*

Thus, it is improper to restrict the method of using GLP-1 compounds, GLP-1 analogs, and GLP-1 derivatives to treat the mortality and morbidity associated with stroke into three groups. This requirement would prevent Applicants from ever having the claim as filed considered on the merits.

In conclusion, Applicants respectfully request reconsideration of the restriction requirement especially with respect to Groups I, II, and III. Restriction of the invention into Groups I, II, and III improperly restricts a Markush group. Further, Applicant respectfully notes that Applicant has received issued U.S. Patent No. 6,006,753 titled Use of GLP-1 or Analogs to Abolish Catabolic Changes after Surgery. Claim 1 of this issued patent provides:

> A method of attenuating post-surgical catabolic changes and insulin resistance, comprising, administering to a patient in need thereof a compound selected from the group consisting of GLP-1, GLP-1 analogs, GLP-1 derivatives, and pharmaceutically-acceptable salts

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PTO/SB/17 (12/97)

Approved for use through 09/30/00. OMB 0651-0032

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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FEE TRANSMITTAL

Note: Effective November 1, 1999. Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT ($)890.00

Complete if Known	
Application Number	09/400,802
Filing Date	September 22, 1999
First Named Inventor	Suad Efendic
Group Art Unit	1653
Examiner Name	F. Moezie
Attorney Docket Number	X-11158

METHOD OF PAYMENT (check one)

1. [X] The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 05-0840

Deposit Account Name: Eli Lilly and Company

[X] Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

[ ] Charge the Issue Fee Set in 37 CFR 1.18 at the Mailing of the Notice of Allowance

2. [ ] Payment Enclosed:

[ ] Check [ ] Money Order [ ] Other

FEE CALCULATION

1. FILING FEE

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) ($)

2. CLAIMS

		Extra		Fee from below		Fee Paid
Total Claims	-20**=		X	18	=	
Independent Claims	-3**=		X	80	=	
Multiple Dependent Claims (first time)				270	=	

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	39	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim
109	78	209	39	Reissue independent claims over original patent
110	18	210	9	Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge-late filing fee or oath	
127	50	227	25	Surcharge-late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	890
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive-unavoidable	
141	1,240	241	620	Petition to revive-unintentional	
142	1,210	242	605	Utility issue fee (or reissue)	
143	430	243	215	Design Issue Fee	
144	580	244	290	Plant Issue Fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	240	126	240	Submission of Information Disclosure Stmt.	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other fee (specify)					
Other fee (specify)					

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($)890.00

SUBMITTED BY

		Complete (if applicable)	
Typed Name	Mark J. Stewart, Ph.D.	Reg. Number	43,936
Signature		Date	March 20, 2001

CERTIFICATE OF MAILING

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ELI LILLY AND COMPANY

By: [signature] Date: 3-20-01

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